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| 10/066,566      | 02/06/2002  | Franz Wonisch        | A-7756              | 2626             |

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EXAMINER

THOMSON, MICHELLE R

ART UNIT PAPER NUMBER

3641

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/066,566

Applicant(s)

WONISCH ET AL.

Examiner

Michelle (Shelley) Thomson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 13-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Invention I in Paper No. 4 is acknowledged. The traversal is on the ground(s) that 13-20 are dependent claims which build on the basic concepts of the invention set forth in the independent claim. This is not found persuasive because independent claim 1 is a linking claim to a plurality of properly divisible inventions (See MPEP 809.03). Claims 21-27 are evidence claims, which indicate that the combination does not rely upon the specific details of the subcombination for its patentability (See MPEP 806.05(c) example III). In response to applicant's traverse of the species election of Markush claims, applicant is directed to MPEP 803.02.
2. Claim 1 link(s) inventions II-VIII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and **any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.** Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.
3. The requirement is still deemed proper and is therefore made FINAL.

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4. Claims 13-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 4.

***Information Disclosure Statement***

5. The information disclosure statement filed 2/6/02 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 19.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the barrel nut encompassed by the barrel unit and an outside thread, and the guide groove on the frame must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written

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description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the fastening means and magazine safety means recited in the claim elements and equivalents thereof.

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the bolt being made as a spring-mass bolt.

#### ***Claim Objections***

10. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

#### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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13. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear to the examiner how the barrel unit moves to a rear against a direction of firing when a shot is fired because applicant has disclosed and claimed that the barrel unit is fixed on the frame in an operating state. Does applicant intend the frame to also move to a rear? If so, applicant has not disclosed the frame capable of rearward movement and it would not be obvious to one of ordinary skill in the art to make the firearm having a rearwardly movable frame/barrel and a bolt that moves relative to the frame and barrel unit.

14. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not disclosed what constitutes a spring-mass bolt and the term is not one generally used in the art such that a person of ordinary skill in the art could make the invention.

15. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the screw means for fixing the barrel unit on the frame, does not reasonably provide enablement for the barrel nut being encompassed by the barrel unit, when applicant has disclosed the barrel nut comprising part of the barrel unit. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make the invention commensurate in scope with these claims. It is not clear to the examiner how the barrel unit can encompass the barrel unit.

16. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 7 recites the limitation "the frame bridge" in line 6. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 9 recites the limitation "the barrel block" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-5, 10, and 11 (as best understood by the examiner) are rejected under 35 U.S.C. 102(b) as being anticipated by Rosebush (US Patent # 1,291,688). Rosebush discloses a firearm comprising a grip (reference 11), a frame (reference 10) connected to the grip, a barrel unit (reference 19) fixed on the frame in an operating state of the firearm with a barrel tube and a bolt (reference 30) which can move relative to the frame and the barrel unit, wherein the barrel unit comprises a barrel receiver (fastening means) (reference 16) which allow detachable mounting of the barrel unit on the frame. The barrel unit comprising a barrel block (reference 29) which is securely mounted on an end of the barrel tube, wherein on the barrel block there is a

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rise (reference 24) for inserting a round into the barrel tube and an extractor groove (reference 166) for pulling out an empty shell casing, and a guide rib (reference 21) attached to the bottom of the barrel block which fits into a guide groove (reference 22) on the frame. The fastening means comprise a frame bridge (reference 16) which is attached to the frame and which has a through hole (Figure 24). The bolt has a spring (reference 40) and comprises a mass, and the frame comprises two frame parts (Figure 24) with the same structure and the frame bridge is attached to one of the frame parts.

21. Claims 1, and 6-9 (as best understood by the examiner) are rejected under 35 U.S.C. 102(b) as being anticipated by Donovan (US Patent # 3,776,096). Donovan discloses a firearm comprising a grip (reference 4), a frame (reference 2) connected to the grip, a barrel unit (reference 1) fixed on the frame in an operating state of the firearm with a barrel tube and a bolt (reference 36) which can move relative to the frame and the barrel unit, wherein the barrel unit comprises fastening means which allow detachable mounting of the barrel unit on the frame. The fastening means comprising screw means by which the barrel unit can be fixed on the frame, the screw means comprising a barrel nut (reference 145) on an outside thread in an end area of the barrel tube, the barrel unit further comprising a barrel jacket (reference 140) which is slipped onto the barrel tube from a front such that it can adjoin the barrel nut so that when the barrel nut is tightened the barrel jacket and a barrel block are pressed against a corresponding contact surface of a frame bridge so that the barrel unit is securely fixed on the frame (Figure 5).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosebush as applied to claim 1 above, and further in view of Allen et al. (US Patent # 6,519,887). Although Rosebush does not expressly disclose a magazine safety, Allen et al. does. Allen et al. teaches a magazine safety for a firearm comprising a magazine safety which allows a round to be fired only when a magazine tube has been pushed into the firearm, when the magazine tube has not been pushed in the magazine safety pivotally supported on the frame is pressed by a spring against a connecting rod which connects a trigger to a sear which is dynamically connected to a hammer, the connecting rod in the state pressed down cannot fire a round, and the magazine tube inserted the magazine safety is pressed up against the force of the spring such that the connecting rod moves up into a position such that by actuating the trigger a shot can be fired (column 1, lines 25-40). Rosebush and Allen et al. are analogous art because they are from the same field of endeavor: firearms. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the magazine safety as taught by Allen et al. with the firearm as taught by Rosebush. The suggestion/motivation for doing so would have been to obtain a safer firearm.

### *Conclusion*

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Obregon (US Patent # 2,115,041), Savage (US Patent # 1,320,578), Seiderman (US Patent # 3,208,178), Declaye (US Patent # 1,459,285), Vastag (US Patent # 6,513,274), Blackshaw et al. (US Patent # 4,409,882), and Heinicke (US Patent # 3,755,948).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Thomson whose telephone number is 703.306.4176. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703.306.4198. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

mrt

July 8, 2003

EXAMINER  
SUPERVISOR  
MICHAEL CARONE